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| 09/532,804 | 03/21/2000 | Khalid Monir A. El-Rafie | 03941.86972 | 7370 |

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EXAMINER

EDELMAN, BRADLEY E

ART UNIT PAPER NUMBER

2153

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/532,804

Applicant(s)

EL-RAFIE, KHALID MONIR A.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5,7,9,26-45 and 48-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5,7,9,26-45 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for continued prosecution filed on September 16, 2004. Claims 2-5, 7, 9, and 26-45, and 48-50 are presented for further examination. Examiner has withdrawn the previous restriction requirement because, due to the claim amendments, the claims no longer encompass distinct inventions.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claims 2-5, 7, 9, and 26-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 2, the new limitation of "the satellite source IP address not being encapsulated within an other source IP address" was not described in the specification as originally filed. Although the specification describes using the satellite IP address as

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the source address, and further discloses that the system does not need to use a hybrid gateway (see p. 8, line 18 – p. 9, line 1), the specification does not explicitly disclose *not using* encapsulation to encapsulate the satellite IP address with another source IP address. Perhaps the system taught by Applicant's specification sends the satellite source IP address unencapsulated by another source IP address, but perhaps not. Because Applicant did not describe such a feature in the specification as originally filed, the limitation of "the satellite source IP address not being encapsulated within an other source IP address" constitutes new matter.

Claims 26-31 depend from claim 2 and are thus rejected for the same reason.

Claims 3, 7, and 9 contain the same limitation as claim 2, and are thus rejected for the same reason.

Claims 4, 5, and 32-38 depend from claim 3, and are thus rejected for the same reason.

2. Claims 3-5, 7, 9, 32-45, and 48-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claim 3, the term "the satellite source IP address" on line 8 of the claim lacks sufficient antecedent basis. Claim 7 has the same problem on lines 11-12 of the claim, and claim 9 has again the same problem on line 10.

Claims 4, 5, and 32-38 depend from claim 3, and are thus rejected for the same reason.

In considering claim 38, the phrase "the ISP" on line 4 lacks sufficient antecedent basis.

In considering claim 39, the modifying phrase "that is not encapsulated within another source address" is ambiguous because it is unclear whether it modifies the "data packet" or the "source address" previously mentioned in the claim. Claims 42 and 48 have this same problem.

Claims 40-41 depend from claim 39, and are thus rejected for the same reason.

Claims 42 and 48 contain the same limitation as claim 39 and are thus rejected for the same reason.

Claims 40-41, 43-45, and 49-50 depend from claims 39, 42, and 48 respectively, and are thus rejected for the same reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 39, 40, 42, 43, 45, and 48-50, as understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Dillon et al. (U.S. Patent No. 6,571,296, hereinafter "Dillon").

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Note: Regarding claim 39, Examiner has interpreted the phrase "that is not encapsulated within another source address" as modifying the "source address."

In considering claim 39, Dillon discloses an asymmetric satellite based terminal device ("personal computer," "hybrid terminal 110," Fig. 1; col. 3, lines 51) comprising:

A modem ("modem," col. 4, line 12) in communication with an Internet Host ("application server 140") via a terrestrial link (col. 3, lines 47-61; Fig. 1);

A satellite card in communication with an Internet Host via a satellite link ("satellite interface hardware 120," col. 4, line 13);

A storage device having computer-readable instructions stored thereon for performing steps comprising:

Creating a data packet having a source address assigned to a centralized uplink center of a satellite service (col. 4, lines 45-46, wherein the "hybrid service provider" allocates IP addresses to the satellite receivers; col. 5, lines 4-12, wherein the hybrid terminal creates a data packet that "has a source IP address corresponding to satellite interface 120"); and

Sending the data packet from the modem to the Internet Host via the terrestrial link (col. 5, lines 14-33, wherein the packet is sent via a SLIP Provider and hybrid gateway, and eventually arrives via the terrestrial link at the Host).

In considering claim 40, Dillon further discloses that the storage device further includes instructions for performing the step of receiving data at the satellite card from

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the Internet Host via the satellite link in response to the data packet being sent from the modem (col. 5, lines 58-67).

Claim 42 presents a method for performing the same steps disclosed in claim 39, and is thus rejected for the same reasons.

Claim 43 presents a method for performing the same steps disclosed in claim 40, and is thus rejected for the same reasons.

In considering claim 45, Dillon further discloses assigning an IP address assigned to an uplink center of a satellite network to the terminal device (i.e. IP address corresponding to the satellite interface 120 assigned by the hybrid service provider, col. 4, lines 42-46), wherein, for the step of creating, the source address matches the IP address assigned to the uplink center (col. 5, lines 10-13).

Claim 48 presents a computer readable medium having computer-readable instructions for performing the same steps disclosed in claim 39, and is thus rejected for the same reasons.

Claim 49 presents a computer readable medium having computer-readable instructions for performing the same steps disclosed in claim 40, and is thus rejected for the same reasons.

Claim 50 presents a computer readable medium having computer-readable instructions for performing the same steps disclosed in claim 45, and is thus rejected for the same reasons.

Response to Arguments

Applicant has argued that Dillon does not disclose the invention as presently claimed. Regarding claims 2-5, 7, 9, and 26-37, Examiner agrees. Regarding claims 39, 40, 42, 43, 45, and 48-50, Examiner disagrees, for the reasons stated in the claim rejections above.

Note that the claims remain rejected under 35 USC 112, 1st and 2nd paragraphs, as discussed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bradley Edelman

BE
January 7, 2005